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| EXAMINER |
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LAZORCIK, JASON L

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| ART UNIT | PAPER NUMBER |
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1791

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| NOTIFICATION DATE | DELIVERY MODE |
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10/30/2007

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

Office Action Summary

Application No.

10/767,057

Applicant(s)

ATOBE ET AL.

Examiner

Jason L. Lazorcik

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 August 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7 and 14-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7 and 14-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

The request for a continued prosecution application (CPA) under 37 CFR 1.53(d) filed on [1] is acknowledged. 37 CFR 1.53(d)(1) was amended to provide that the CPA must be for a design patent and the prior application of the CPA must be a design application that is complete as defined by 37 CFR 1.51(b). See *Elimination of Continued Prosecution Application Practice as to Utility and Plant Patent Applications*, final rule, 68 Fed. Reg. 32376 (May 30, 2003), 1271 Off. Gaz. Pat. Office 143 (June 24, 2003). Since a CPA of this application is not permitted under 37 CFR 1.53(d)(1), the improper request for a CPA is being treated as a request for continued examination of this application under 37 CFR 1.114.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 7 and 14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The amended claim 7 presents a limitation wherein a mixture of carbon and silica/alumina are either loaded into the space between two filter material or dispersed in one of the filter materials. The newly added limitation instructs that in either of these embodiments, "a total amount of the mixture of activated charcoal is between 30 and 120mg. Applicants specification explicitly states (Page 5, lines 11-20) that "where the adsorbents are contained in the space between the filter materials, the total amount of the adsorbents should be set to ... preferably 30 to 120 mg per 5 mm of the space". The specification further states that "where the adsorbents are contained in the filter material, the total amount of the adsorbents should be set to ... preferably 20 mg to 60 mg, per 10 mm of the filter material. The specification as originally filed does not provide support for the scenario wherein the mixture is dispersed in one of the filter materials and wherein a total amount of the mixture of activated charcoal and silica/alumina is set to 30mg to 120mg. Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 7 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by Ogasa (US 4,038,922).

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Ogasa teaches (Column 2, lines 26-49) a blended granular filter material for insertion into the central void space of a traditional plug-space-plug type tobacco filter (see figure 1). The first material of the blend comprises 30-95% by weight of an "excipient material" selected from the group of materials including zeolite (e.g. "silica/alumina"). The remaining 5 to 70% weight of the first blend material comprises a protein based coating upon the zeolite excipient material. Ogasa refers to this first material of the blend as the "protein granules".

In a preferred embodiment the protein granules discussed above are blended with the second blend material of activated charcoal to form a "composite granule". Regarding this composite granule, Ogasa teaches that a preferred composition of the first and second blend materials includes from 40 to 80% by weight of the protein granules and from 20 to 60% by weight of the charcoal granules. The instant disclosure is understood to encompass a blend composition comprising a 1:1 ratio of activated carbon to zeolite material. Finally, the reference teaches an embodiment wherein 100mg of the composite granules are loaded into the central space of the plug-space-plug filter.

Claims 14-16 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Ogasa (US 4,038,922).

As set forth above, Ogasa teaches loading 100mg of a composite granule filter material into the void space of a plug space plug filter. The reference teaches at least

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one embodiment wherein the composite granules comprise a blend of zeolite and activated carbon in a 1:1 ratio.

While the reference does not explicitly address the presence of “plug wrap paper” circumscribing the filter sections, “forming paper” for integrating the individual filter sections, or “tipping paper” for securing the multi-section filter to the tobacco column, said features are understood to be implicitly covered by the Ogasa structure.

Alternately, should Applicant argue that the wrapper materials are not implicitly disclosed by the Ogasa teachings, it is then the Examiners position that they represent a merely trivial and obvious modification over the prior art teachings for one of ordinary skill in the art at the time of the invention. Specifically, one of ordinary skill in the tobacco arts would have recognized the claimed wrappers as merely conventional means for constructing the multi-element filter and cigarette disclosed in the prior art.

Next, Ogasa provides several discrete embodiments of the cigarette filter that use a total mass of filter material which fall within Applicants preferred range of between “30 to 120 mg per 5 mm of space”. Ogasa provides no explicit limitations upon the mass of filter material to be loaded into the void of the plug-space-plug filter. While the instant reference is silent regarding Applicants particular embodiment of 30mg of activated carbon and 30 mg of zeolite, such an embodiment deviates from the Ogasa teachings by such a minor extent as to be patentably indistinguishable from the prior art. Therefore, absent any compelling evidence to the contrary, it is the Examiners position that the prior art teachings either encompass the claimed cigarette structure or alternately that the Ogasa teachings render said limitation as obvious.

Specifically, one of ordinary skill in the art would recognize that the mass of filter material loaded into the Ogasa filter would create a result effective relationship or a performance tradeoff subject to empirical optimization. For instance, increasing the mass loading of filter material would be expected to enhance the filtration efficiency but at the cost of an increased pressure drop across the filter. It would therefore be well within the prevue of one trained in the tobacco arts to empirically optimize the mass of filter material utilized in the plug-space-plug structure disclosed by Ogasa. In view of the foregoing, Applicants claimed embodiment wherein 30mg of activated charcoal and 30 mg of silica/alumina zeolite are loaded into the filter represents a merely obvious modification over the Ogasa disclosure.

Response to Arguments

Applicant's arguments with respect to claim have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Applicant should carefully consider the scope and content of each of the cited referenced when constructing a response to the instant office action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason L. Lazorcik whose telephone number is (571)


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272-2217. The examiner can normally be reached on Monday through Friday 8:30 am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Griffin can be reached on (571) 272-1189. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JLL


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